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10/821,490

04/09/2004

Kirt A. Winter

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7590 03/18/2009
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

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| EXAMINER |
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HUNTSINGER, PETER K

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIRT A. WINTER; YOAV EPSTEIN; WILLIAM C. HILLIARD

Application 10/821,490
Technology Center 2600

Mailed: March 17, 2009

Before KRISTA ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This application was electronically received by the Board of Patent Appeals and Interferences on December 17, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed September 22, 2008, under the heading "Grounds of rejection to be Reviewed on Appeal" is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

A review of the last Office Action of record mailed March 4, 2008, finds that claims 21-37, 39-41, 43-65, 68-70, 72-93, 95, 113, 114, 117, 123-127 and 129-134 are rejected according to the PTOL-326 Office Action Summary Sheet, however, a review of the Action itself does not find any rejection of claims 60, 113, 114, 123-126, 129, 130, 131 and 134. Therefore, it is unclear if claims 60, 113, 114, 123-126, 129, 130, 131 and 134 are rejected.

A review of the Examiner's Answer finds that it is unclear what rejected claims are on appeal as compared to the Appeal Brief and/or the Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the brief.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all pending claims.

CONCLUSION

Accordingly, it is ORDERED that the application be returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed September 22, 2008;
- 2) to generate a new Examiner's Answer setting forth the correct Grounds of rejection to be reviewed on appeal and to correct other sections of the Answer as may be required;
- 3) and to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and
- 4) such further action as may be required.

KZ/MV/MAT

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins CO 80527-2400